

Sub C
B7

35. (Once Amended) The method of claim 34 wherein the receiving step includes receiving identification indicia from the remote communication unit and the obtaining step includes accessing the predefined parameter defining a transaction guideline or limitation in a database using the identification indicia, the database being located apart from the remote communication unit.

36. (Once Amended) The method of claim 34 wherein the receiving step includes receiving the predefined parameter defining a transaction guideline or limitation from the remote communication unit.

Attached is a marked-up version of the amendments made to the application by the current response. The attachment is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

REMARKS

Objection to Abstract

Applicant has replaced the Abstract so that the beginning phrase "The present provides" has been removed. This alleviates the Patent Offices' rejection in the Abstract.

Objections to Claims 1-3, 9-10, 17-19, and 21-24

The Patent Office objected to claims 1-3, 9-10, 17-19, and 21-24 because the phrase "adapted to" was used to define the functionality of the control system. The examiner used *In re* Hutchison, 69 USPQ 138 to support these rejections. The Applicant respectfully traverses these objections and would like to bring to the attention of the Patent Office that this same rejection was brought in the parent case (Serial No. 09/152,564) to the present continuation application, in an office action mailed on December 7, 2000 by Examiner Dalencourt. The Applicant responded in the exact same manner as is indicated below in a response dated February 20, 2001, and the Patent Office accepted such response as overcoming this rejection since the rejection was not withdrawn in the next final Office Action by the Patent Office mailed on May 3, 2001. The analysis is repeated below again for the convenience of the Patent Office.

The Patent Office has misapplied *In re Hutchison* to these claims. First, there is no rule against defining the functionality of an element in a claim. In fact, function of an element, especially an element such as a control system, may be the only true way to define an element in a definitive manner, as required by patent law. Means-plus-function claims rely solely on an element's functionality. Similarly, computer-related claims require the definition of functionality in order to separate a generic computer functioning in one way from that of a second computer functioning in another way. Clearly, defining and relying on function in a claim is far from improper, and is often required.

In the present system claims, the "control system," preferably a computer-related system, is defined by its ability to receive indicia from a remote communication unit and control a transaction at the transaction interface involving the remote communication unit in a select manner. As such, the operation of the control system is necessarily defined to properly claim the invention. Because the control system is adapted to function as defined above, it must be construed as a positive limitation, because the control system is adapted to operate in the defined manner. The phrase "adapted to," as provided in the pending claims, is used in a manner reciting a positive limitation for a control system.

Unlike the present invention, the phrases "adapted to" and "adapted for use," as used in *In re Hutchison*, were used improperly. Claims 42 and 58 at issue in *In re Hutchison* began as follows:

- 42. As an article of manufacture, adapted for use in the fabrication of a metal template or the like suitable for metal-working operations, a laminated unit comprising...
- 58. As an article of manufacture, adapted to be adhered to a metal backing element for use in the fabrication of a template or the like suitable for metal-working operations...

The claims at issue in *In re Hutchison* were article of manufacture claims including language in the preamble attempting to define how the article would ultimately be used. It is clear from the claims that the article of manufacture being claimed was a specific structure that could be used in any number of ways. The "adapted" language used in the preamble discussing an ultimate application of the article could not be used to actually define the article itself. The court was not rejecting the use of functional language or the use of the term "adapted" in general,

but simply stating that broad application or use statements in a preamble would not serve as limitations in an article of manufacture claim. A copy of *In re Hutchison* is enclosed for the Examiner's review.

Objections to Claims 17-18 and 21-22

Applicant has amended claims 17, 18, 21, and 22 to correct a typographical error to amend "adapted" to "adapted to." This amendment alleviates the Patent Offices' objections to claims 17-18 and 21-22. Further, claims 17-18 and 21-22 are acceptable with the "adapted to" language as discussed above for the objections to claims 1-3, 9-10, 17-19, and 21-24.

Obviousness-Type Double Patenting Rejection

Applicant does not admit that any of the claims of the present invention are obvious in view of any claims in U.S. Patent Nos. 6,098,879 and 6,422,464, but Applicant has included herewith a terminal disclaimer relating to U.S. Patent Nos. 6,098,879 and 6,422,464 to address this rejection.

Rejection of Claims 1-3, 9-10, 13-26, and 34-36 Under 35 U.S.C. § 102(b) – Randleman

The Patent Office has rejected claims 1-3, 9-10, 13-26, and 34-36 under 35 U.S.C. § 102(b) as being anticipated by Randleman (U.S. Patent No. 5,072,380).

Applicant has amended claims 1-3, 6-8, 16-24, and 34-36 to change "predefined parameters" to "a predefined parameter defining a transaction guideline or limitation." The Patent Office cites to Randleman at column 1, line 26 - column 2, line 2, and column 4, lines 19 - 65 to support the position that Randleman discloses "controlling a transaction at the transaction interface according to predefined parameters defining a limitation or guideline for the transaction associated with the remote communication unit" (Office Action dated 1-23-2003, p. 6). Randleman does not disclose this limitation. Instead, Randleman only interrogates a remote communication unit, or transponder, associated with a vehicle to ensure it is present, to identify the vehicle, and record the type and cost of services provided to the vehicle over a given billing period. The Randleman patent focuses on this ability to periodically bill for services provided to a vehicle over a certain period of time, such as a month. Randleman does not disclose controlling a transaction based on a predefined parameter that defines a transaction guideline or limitation. Instead, Randleman merely tracks the

types and costs of services provided to a vehicle to assemble them in a billing period for a specific period of time.

Column 1, line 49 – column 2, line 2 of Randleman specifically discloses the following steps being provided as being part of the Randleman application. First, the system prevents any other electronic identification from other nearby service areas from providing services to the vehicle. Second, the system involves informing the operator of the vehicle of the costs incurred to the vehicle. Third, the system involves transferring data representing the cost or types of services provided to records in a file. Fourth, the system involves determining whether the services are authorized for the vehicle by identifying the vehicle electronically a second time so as to verify that this is the same vehicle that was identified earlier in the process. Lastly, the system assembles all costs for services or the types of service information into a record for a given billing period. None of these basic steps above that disclosed in Randleman involve controlling a transaction based on a predefined parameter that defines a transaction guideline or limitation. Instead, Randleman merely tracks the types and costs of services provided to a vehicle to assemble them in a billing period for a specific period of time.

Therefore, claims 1-3, 6-8, 16-24, and 34-36 are patentable over Randleman since these claims include at least one limitation that is not disclosed, either expressly or inherently in Randleman.

Rejection of Claims 6–8 Under 35 U.S.C. § 103(a) – Randleman

The Patent Office rejected claims 6–8 under 35 U.S.C. § 103(a) in view of Randleman. Claims 6–8 depend from claim 1, either directly or indirectly. Claim 1 has been amended by Applicant to require that the invention control a transaction based on a predefined parameter defining a transaction guideline or limitation. For the same reasons as stated above, this limitation is not disclosed expressly or inherently in Randleman. Therefore Randleman cannot be used to maintain this rejection of claims 6–8 since claims 6-8 contain at least one limitation that is not suggested or taught in the prior art used for this obviousness rejection. MPEP § 2143.03.

Rejection of Claims 27-28 Under 35 U.S.C. § 103(a) – Randleman

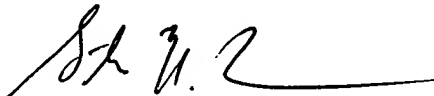
The Patent Office rejected claims 27–28 under 35 U.S.C. § 103(a) in view of Randleman. Claims 27– 8 depend from claim 1, either directly or indirectly. Claim 1 has been amended by

Applicant to require that the invention control a transaction based on a predefined parameter defining a transaction guideline or limitation. For the same reasons as stated above, this limitation is not disclosed expressly or inherently in Randleman. Therefore Randleman cannot be used to maintain this rejection of claims 27-28 since claims 27-28 contain at least one limitation that is not suggested or taught in the prior art used for this obviousness rejection. MPEP § 2143.03.

Respectfully submitted,

WITHROW & TERRANOVA, PLLC

By:


Steven N. Terranova
Registration No. 43,185
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: March 26, 2003
Attorney Docket: 2400-171A

CERTIFICATE OF MAILING	
I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST-CLASS MAIL, IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231, ON <u>03/26/03</u> (Date of Deposit)	
<u>Rebecca A. Harter</u>	_____ Name of Depositor
<u>Rebecca A. Harter</u>	_____ Signature
<u>March 26, 2003</u>	_____ Date of Signature

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Abstract:

Please replace the Abstract with the following:

[The present invention provides a] A fuel dispensing system for setting transaction parameters in association with a remote communications unit. This system will include wireless or radio communications electronics adapted to receive signals from remote communications units, a transaction interface for carrying out transactions, and a control system and associated memory operating in conjunction with the communications electronics and a transaction interface. The control system is adapted to receive indicia from a remote communications unit and control the transaction at the transaction interface involving the remote communications unit according to predefined parameters associated with the remote communications unit. Any identification indicia and predefined parameters may be stored in the memory in association with the remote communications unit and the control system may be adapted to access these predefined parameters in the memory upon receipt of the identification indicia and control the transaction accordingly. Alternatively, the predefined parameters may be transmitted directly from the remote communications unit to the communications electronics and control system. The predefined parameters may limit a transaction to a select type or grade of fuel, a select type or amount of a product or service, as well as limiting or preventing the purchase of certain products or services. Notably, the control system may include a dispenser control system, a central site control system, a control system associated with a remote network, or a combination thereof.

In the Claims:

Please amend claims 1 – 3, 6 – 8, 16 – 24, and 34 – 36 as follows:

1. (Twice Amended) A system for providing transaction parameters in association with a remote communication unit comprising:
 - e) wireless communication electronics adapted to receive signals including indicia from remote communication units;

- f) a transaction interface for carryout transactions;
- g) a control system and memory associated with said communication electronics and said transaction interface; and
- h) said control system adapted to receive the indicia from a remote communication unit and control a transaction at the transaction interface involving the remote communication unit according to a predefined [parameters defining a limitation or guideline for the transaction] parameter defining a transaction guideline or limitation associated with a remote communication unit.

2. (Once Amended) The system of claim 1 wherein the indicia is identification indicia and said predefined [parameters] parameter defining a transaction guideline or limitation stored in said memory in association with the identification indicia of the remote communication unit and said control system is adapted to access said predefined [parameters] parameter defining a transaction guideline or limitation in said memory upon receipt of the identification indicia and control the transaction accordingly.

3. (Once Amended) The system of claim 1 wherein the predefined [parameters] parameter defining a transaction guideline or limitation are transmitted to the communication electronics from said remote communication unit and said control system is adapted to receive the predefined [parameters] parameter defining a transaction guideline or limitation and control the transaction accordingly.

6. (Once Amended) The system of claim 1 wherein the predefined [parameters] parameter defining a transaction guideline or limitation limit a transaction to a purchase amount.

7. (Once Amended) The system of claim 1 wherein the predefined [parameters] parameter defining a transaction guideline or limitation control a transaction by preventing purchase of select product.

8. (Once Amended) The system of claim 1 wherein the predefined [parameters] parameter defining a transaction guideline or limitation control a transaction by limiting a quantity of a select product.
16. (Once Amended) The system of claim 1 further comprising means for alerting a customer of a predefined [parameter] parameter defining a transaction guideline or limitation associated with said control system.
17. (Once Amended) The system of claim 16 wherein said control system is adapted to cause said means to alert the customer when a predefined [parameter] parameter defining a transaction guideline or limitation is reached during a transaction.
18. (Once Amended) The system of claim 16 wherein said control system is adapted to cause said means to alert the customer that a predefined [parameter] parameter defining a transaction guideline or limitation exists.
19. (Once Amended) The system of claim 16 wherein said control system is adapted to monitor a transaction for actions violating the predefined [parameter] parameter defining a transaction guideline or limitation and cause said means to alert the customer of an action violating the predefined parameters.
20. (Once Amended) The system of claim 1 further comprising means for alerting an operator of a predefined [parameter] parameter defining a transaction guideline or limitation associated with said control system.
21. (Once Amended) The system of claim 20 wherein said control system is adapted to cause said means to alert the operator when a predefined [parameter] parameter defining a transaction guideline or limitation is reached during a transaction.

22. (Once Amended) The system of claim 20 wherein said control system is adapted to cause said means to alert the operator that a predefined [parameter] parameter defining a transaction guideline or limitation exists.

23. (Once Amended) The system of claim 20 wherein said control system is adapted to monitor a transaction for actions violating the predefined [parameter] parameter defining a transaction guideline or limitation and to cause said means to alert the operator of an action violating the predefined parameters.

24. (Once Amended) The system of claim 1 wherein said control system is adapted to monitor a transaction for actions violating the predefined [parameter] parameter defining a transaction guideline or limitation and prevent actions in the transaction violating the predefined parameters.

34. (Twice Amended) A method for enforcing a predefined [transaction parameters] parameter defining a transaction guideline or limitation associated with a remote communication unit comprising:

- c) receiving information from a remote communication unit in association with a transaction;
- d) obtaining predefined [parameters] parameter defining a transaction guideline or limitation defining a limitation or guideline for the transaction associated with the remote communication unit; and

controlling the transaction according to the predefined [parameter] parameter defining a transaction guideline or limitation.

35. (Once Amended) The method of claim 34 wherein the receiving step includes receiving identification indicia from the remote communication unit and the obtaining step includes accessing the predefined [parameter] parameter defining a transaction guideline or limitation in a database using the identification indicia, the database being located apart from the remote communication unit.

36. (Once Amended) The method of claim 34 wherein the receiving step includes receiving the predefined [parameter] parameter defining a transaction guideline or limitation from the remote communication unit.